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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,597	09/05/2003	David C. Howda	S-12	7953
21394 7590 09/23/2008 ARTHROCARE CORPORATION 7500 Rialto Boulevard Building Two, Suite 100 Austin, TX 78735-8532				
EXAMINER PEPFLY, MICHAEL F				
ART UNIT 3739		PAPER NUMBER		
NOTIFICATION DATE 09/23/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel\_prop@arthrocure.com

### Office Action Summary

**Application No.**

10/656,597

**Applicant(s)**

HOVDA ET AL.

**Examiner**

Michael Peffley

**Art Unit**

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.  
4a) Of the above claim(s) 1-26 and 46 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 27-45 and 47 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date 5/5/08; 7/1/08  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

Applicant's amendments and comments, received July 1, 2008, have been fully considered by the examiner. The following is a complete response to the July 1, 2008 communication.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Information Disclosure Statement***

Applicant should note that the large number of references in the IDS of June 4, 2007 have been considered by the examiner in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. **See MPEP 609.05(b)**. Applicant is requested to point out any particular references in the IDS which they believe may be of particular relevance to the instant claimed invention in response to this office action.

### ***Election/Restrictions***

Claims 1-26 and 46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 2/13/06.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27-45 and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure of an active electrode that is radially and fixedly spaced from the return electrode. The language “fixedly spaced” does not exist in the originally filed specification, and the specification makes it clear that the electrodes are expanded from a retracted position to an expanded position (paragraphs [0110-0111]). There is simply no disclosure that the electrodes are fixed relative to one another.

***Claim Rejections - 35 USC § 102***

Claims 27, 29, 30, 32-45 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Maguire et al. (US 6997925).

In figure 21A Maguire et al. disclose an electrosurgical device comprising a shaft having a distal portion; a return electrode (2130) at the distal portion of the shaft and having a return electrode surface area, the return electrode distally terminating in a tip portion; at least one active electrode (2126) at the distal portion of the shaft and having an active electrode surface area, the active electrode further comprising an arm portion being radially spaced from the return electrode, wherein the tip portion of the return electrode is distally spaced from the arm portion of the active electrode; and a connector located at the proximal portion of the shaft and adapted to couple the return electrode and each active electrode to respective poles of the high frequency power supply.

As addressed above, there is no specific support for the active electrodes being radially and fixedly spaced from the return electrode. The examiner is interpreting the language to mean that once the electrodes are in their expanded state, the active electrodes remain fixed. The examiner maintains that the Maguire et al electrodes operate in an identical manner with the active electrodes deployed to an expanded condition around the return electrode. Once in this position, the active electrodes are "fixedly spaced" relative to the return electrode. Again, the deployment of the Maguire et al electrodes is identical to the disclosed operation of applicant's invention.

***Claim Rejections - 35 USC § 103***

Claims 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maguire et al. Maguire et al. teach all of the limitations of the claims except the return electrode having a surface area greater than the active electrode and the raised surface area comprising a coil. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the return electrode with a greater surface area than the active electrode and to provide a coil as the raised surface area since it has been held that changing the size and shape of the essential working parts of a device only involves routine skill in the art.

***Response to Arguments***

Applicant's arguments and remarks filed July 1, 2008 have been considered but are not deemed persuasive. As asserted above, the examiner maintains that there is no support in the original disclosure for active electrodes that are "fixedly spaced" from the return electrode as now set forth in the claims. Applicant's specification makes clear

that the electrodes are deployed from a retracted position to an expanded position, thereby indicating that the electrodes are clearly movable (i.e. not fixed) relative to each other. Further, the examiner maintains that upon deployment of the electrodes in the Maguire et al device (i.e. as shown in Figure 21A), the active electrodes remain in the fixed position relative to the return electrode until the electrodes are again moved (just as with applicant's disclosed invention). In light of that interpretation, the Maguire et al active electrodes are deemed to read on the phrase "fixedly spaced" with respect to the return electrode.

Applicant has not substantively argued the obviousness rejection of the claims other than to assert they depend from claims now deemed by applicant to be allowable. The examiner maintains the obviousness rejections remain tenable, and that the amended claim remain anticipated as asserted above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 7am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Peffley/  
Primary Examiner, Art Unit 3739

/mp/  
September 17, 2008